II. Provisional Obvious Double Patenting

The Office has maintained its provisional rejection of claims 22-58 under the judicially-created doctrine of obviousness-type double patenting, as being unpatentable over claims 29-61 of co-pending Application No. 09/600,136. (Office Action, pages 2-3.) Although Applicants disagree with the rejection, they nevertheless enclose a terminal disclaimer, thereby obviating the rejection. Accordingly, Applicants request withdrawal of the rejection.

III. Rejections Under 35 U.S.C. § 103 over Aaslyng'999 in view of Audousset

The Office has newly rejected claims 22-58 under 35 U.S.C. § 103, as being unpatentable over WO'97/19999 (instead of WO'97/19998 of the previous rejections) (hereinafter referred to as "*Aaslyng*'999") in view of U.S. Patent No. 5,769,903 ("*Audousset*") as asserted at page 3 of the Office Action. Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness, the Office must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. *See* M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In addition, the prior art relied upon by the Office must teach or suggest each and every claim limitation. MPEP § 2143. In the present case, the Office has failed to make

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a prima facie case of obviousness because it has not met any, let alone all of the above criteria.

As a basis for its rejection, the Office alleges that *Aaslyng*'999 teaches a dyeing composition comprising various individual components, including "para-aminophenols (see page 9, line 25.)" (Office Action, page 3.)

Applicants submit that *Aaslyng*'999 discloses the singular "para-aminophenol" as a species of oxidation base at page 9, line 25, rather than the plural genus of "para-aminophenols" as alleged by the Office. Applicants do not believe the references support the Office's conclusion, nor has the Office pointed to the specific passages in the references that could support its position. For this reason, Applicants submit that *Aaslyng*'999 fails to disclose the 3-methyl-4-aminophenol oxidation base or addition salt thereof, as is recited in all of the instant claims. In addition, Applicants submit that Audousset also fails to disclose the 3-methyl-4-aminophenol oxidation base, or addition salt thereof. Accordingly, the Office has failed to make a *prima facie* case of obviousness because the cited references do not teach or suggest all the claim limitations.

Furthermore, *Audousset* merely teaches compositions comprising at least one oxidation base, at least one coupler selected from indole couplers, and at least one additional heterocyclic coupler. *See Audousset*, column 2, line 10 to column 3, line 58. The Office has pointed to nothing in *Audousset* that would have led to the addition of a 3-methyl-4-aminophenol oxidation base to the composition of *Aaslyng*'999, nor has the Office even made such an allegation. Accordingly, it appears that the Examiner has therefore failed to indicate how the combination of references teaches all of the claim

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limitations, particularly a composition comprising an oxidation base chosen from 3-methyl-4-aminophenol and the addition salts thereof, and at least one laccase enzyme.

The Office urges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Aaslyng*'999 using the teachings of *Audousset* to devise the claimed invention. (Office Action, pages 4-5.) In support of this rejection, the Office states:

> [s]uch modification would be obvious because one would expect that use water, organic solvents, direct dye and surfactants with a multicompartment device as taught by Audousset **would be similarly useful and applicable** to the analogous composition taught by Aaslyng.

(*Id.*, emphasis added.) Applicants respectfully submit that this argument lacks the required motivation and expectation of success and fails to meet the Office's burden of establishing a prima facie case of obviousness.

The Federal Circuit has held that there must be a clear and particular suggestion in the prior art to combine the teachings of the cited references in the manner proposed by the Examiner. As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re* Dembiczak 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner can meet the burden of establishing a prima facie case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine

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the relevant teachings of the references." *In re Fine,* 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added).

On January 18, 2002, the Federal Circuit again reaffirmed the Examiner's high burden to establish a prima facie case of obviousness and emphasized the requirement for specificity. In *In re Sang-Su Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." 277 F.3d 1338, 1433 (Fed. Cir. 2002). Further, the Federal Circuit explained that

> [t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Id. (internal citations and quotation omitted) (emphasis added).

In the present case, Applicants respectfully submit that the requisite objective teaching is not present in the references. For example, one of ordinary skill in the art reading the cited references would not be motivated to substitute p-aminophenol with 3-methyl-4-aminophenol. Moreover, modifying the references by merely selecting certain possible components from each reference to devise the composition of the claimed invention, without further motivation in the art, is an insufficient basis for maintaining a prima facie case of obviousness. Applicants submit that the Office has failed to show an objective teaching in the cited references or that knowledge generally available to one of

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ordinary skill in the art would lead an individual to combine the relevant teachings of the references to devise the present invention.

Accordingly, Applicants respectfully request that the Office reconsider and withdraw the rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: _____
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Dated: July 23, 2002

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